

REMARKS

Reconsideration of the present application is respectfully requested in light of the foregoing amendments and the following remarks, which are responsive to the Final Office Action mailed June 10, 2003.

1. Amendments to the Specification:

Applicant has complied with the Examiner's request to cancel material deemed to be new matter by the examiner.

2. Claim Rejected Under 35 U.S.C. §112:

The Examiner has rejected claim 4 under 35 U.S.C. §112 as being indefinite. The Examiner contends that there is no antecedent basis for the limitation "the set of participants" and suggests that the limitation be amended to read "a set of participants. The Examiner's suggestion has been adopted by Applicant and claim 4 has been amended accordingly.

3. Claims Rejected Under 35 U.S.C. §103(a):

The Examiner has rejected claims 1-31 pursuant to 35 U.S.C. § 103(a) as being unpatentable over *Brock* in view of several secondary references. Applicant respectfully traverses this rejection on the basis that the Examiner has failed to establish a prima facie case in support of the rejection.

It is well settled that it is the burden of the Examiner to establish a prima facie case of obviousness when rejecting claims under 35 U.S.C. § 103. *In re Reuter*, 651 F.2d 751, 210 U.S.P.Q. 249 (CCPA 1981); MPEP § 2142. If a prima facie case of obviousness is not established, a rejection under 35 U.S.C. § 103 is improper and the Applicant need not present evidence of non-obviousness to overcome such a rejection. *Id.*

In order to establish a *prima facie* case of obviousness, the Examiner must cite to prior art that teaches or suggests all claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974) (emphasis is added). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *See* MPEP § 2143.03.

Claim 2 of the application, as originally submitted, added the limitation to its parent claim, claim 1, of:

providing a set of candidates with an audio/video capture mechanism that is connectable to a machine that permits two-way communication across the distributed computer network, the set of candidates comprising a first portion of the set of potential candidates.

The sole reference cited by the Examiner in support of his rejection of this particular limitation was *Brock*. More specifically, the Examiner states, beginning in the last paragraph of page 5 of the Office Action:

As per claim 2, *Brock* discloses the additional step of providing a set of candidates with an audio/video capture mechanism that is connectable to a machine that permits two-way communication across the distributed computer network, the set of candidates comprising a first portion of the set of potential candidates (see page 10, ¶ 105)

However, as to the limitation in question (i.e., the limitations of claim 2), *Brock* cannot be considered prior art. The reason for this is that the particular portion of *Brock* upon which the Examiner relied in his rejection (i.e., paragraph 105) was not included in the provisional parent of *Brock*. In other words, paragraph 105 of *Brock* constitutes new matter with respect to the parent of *Brock*. Accordingly, paragraph 105 of *Brock* cannot be afforded the same critical date for purposes of determining whether it is prior art with respect to the instant application.

The discrepancy in the contents of the specification of *Brock* and its provisional parent is of critical importance because the filing date of the instant application (June 18, 2001) falls between the filing date *Brock*'s provisional parent (September 1, 2000) and *Brock* filing date (September 4, 2001). Therefore, although portions of *Brock* could be considered to be prior art with respect to the instant application, those portions of *Brock* not contained in the provisional parent of *Brock*, including paragraph 105 among others, cannot.

It is understandable to Applicant that the Examiner would assume that the specification in *Brock* would not contain any new matter. However, paragraph 105 of *Brock* was clearly added with the filing of the *Brock* non-provisional application. A copy of the provisional parent of *Brock* (Application Serial No. 60/229,862) is included with this response for the Examiner's reference and comparison with *Brock*.

In the absence of paragraph 105, *Brock*, as well as all the other references cited by the Examiner in the Office Action, are completely devoid of any teaching or suggestion to incorporate the limitations of claim 2 of the present application. Therefore, the Examiner has not cited any prior art which teaches or suggests such limitations and has thus failed to make a *prima facie* case for obviousness under 35 U.S.C. §103.

Applicant has amended independent claims 1, 12 and 21 to include the limitations of original claim 2. Claims 2 and 23 have been canceled as redundant in view of the amendment to claims 1 and 21. Also cancelled are claims 19, 20 and 27-31 which are for automated embodiments of the present invention which are not suitable for inclusion of audio/video display and communications.

For the foregoing reason, and in view of the claim amendments, it is believed that independent claims 1, 12 and 21 are now in condition for allowance. It is also believed that claims 3-11, 13-18, 22 and 24-26, are in condition for allowance by virtue of being dependents of nonobvious claims. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP § 2143.03.

CONCLUSION

Applicant submits that these amendments and remarks, when entered, place claims 1, 3-18, 21, 22, and 24-26 in condition for allowance and respectfully request that such action be taken by the Examiner at this time.

Should a conference be necessary or desirable to assist the Examiner's evaluation of this application, a telephone call to the undersigned at (305) 448-7089 is respectfully solicited.

Dated: December 2, 2003

By:



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